

8-25-03

#7  
9/3/03

AF/3632

## TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.  
020014

In Re Application Of: Alan B. Shuey

Serial No.  
10/085,543Filing Date  
February 28, 2002Examiner  
Korie H. ChanGroup Art Unit  
3632

Invention:

Cable Support Systems

RECEIVED

SEP 02 2003

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

GROUP 3600

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

The fee for filing this Appeal Brief is: \$160.00 (3)

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 502395
- A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence  
is being deposited with the United  
States Postal Service as Express MailNo. EL 978 301 940 05

in an envelope addressed to:

Mail Stop APPEAL BRIEF - PATENTSCommissioner for Patents, P.O. Box 1450  
Alexandria, VA 22313-14508/22/03 Mari McElhenny  
Date - Signature, Paul A. Beck & Associates

RECEIVED

SEP 02 2003

GROUP 3600

John C. Thomas III  
Signature

Dated: August 22, 2003

John C. Thomas, III (Reg. No. 52,282)  
Paul A. Beck and Associates  
1575 McFarland Road  
Suite 100  
Pittsburgh, PA 15216-1808  
Telephone: (412) 343-9700  
Fax No.: (412) 343-5787

I certify that this document and fee is being deposited  
on \_\_\_\_\_ with the U.S. Postal Service as  
first class mail under 37 C.F.R. 1.8 and is addressed to the  
Assistant Commissioner for Patents, Washington, D.C.  
20231.

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

CC:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED

SEP 02 2003

GROUP 3600

In Re Application: Alan B. Shuey

Serial No. 10/085,543

Confirmation No. 9808

Filed: February 28, 2002

Group Art Unit: 3632

Examiner: Korie H. Chan

Supervisory Patent Examiner: Les Braun

Assignee: Ductmate Industries, Inc.

Title of Invention:  
Cable Support Systems

I hereby certify that this correspondence  
is being deposited with the United  
States Postal Service as Express Mail  
No. EL 97830144005

In an envelope addressed to:  
Mail Stop APPEAL BRIEF- PATENTS  
Commissioner for Patents, P.O. Box 1450  
Alexandria, VA 22313-1450

8/22/03 Maureen McCarthy  
Date - Signature, Paul A. Beck & Associates

**BRIEF ON APPEAL**  
**37 CFR 1.192**

1. REAL PARTY IN INTEREST

The real party in interest is the Assignee, Ductmate Industries, Inc., a Pennsylvania corporation.

2. RELATED APPEALS

There are no related appeals.

3. STATUS OF CLAIMS

This application, originally as filed, contained twenty-two (22) claims. A restriction request was made by the Examiner to restrict the claims. In a telephone interview with the Examiner Jinhee Lee on April 30, 2002 Applicant's Counsel, George Raynovich, Jr., made a provisional election without traverse to prosecute claims 1, 3-5, 8-10, and 14-16. This was

confirmed in the Examiner's Official Action dated November 21, 2002 and in Applicant's Amendment dated January 29, 2003 and filed January 29, 2003 in response to the November 21, 2002 Office Action. The January 29, 2003 Amendment canceled claim 1 and amended claim 3 to be written in independent format and to include what was previously claimed in claim 1. In an April 7, 2003 Office Action claims 3-5, 8-10 and 14-16 were rejected and the rejection was made final. The claims on appeal are claims 3-5, 8-10, and 14-16. These claims appear in the Appendix attached to the Brief.

#### 4. STATUS OF AMENDMENTS

There has been no Official Amendment filed after the final rejection of the Examiner dated April 7, 2003. Applicant proposed claim amendments on April 24, 2003 but the Examiner in a telephone interview indicated that the proposed amendment would not remove or change the rejections.

#### 5. SUMMARY OF INVENTION

This invention relates to an apparatus for suspending an object from an overhead structure by means of cables. The structure of the apparatus provided includes a generally "C" shaped clamp body with a threaded fastener threadingly received within one leg of the "C" shaped body to clamp the "C" shaped body onto an overhead beam. A vertical bore through the clamp body receives a cable to be suspended from the overhead beam. (Page 1 paragraph 0001 lines 1-2, Pages 1-2 paragraph 0003 lines 1-3). The vertical bore includes a conical end portion at the lower part of the vertical bore. A wedge retainer is moveable vertically within the bore. Wedges retained by the wedge retainer contact the cable within the bore when the retainer is at the lower

part of the bore. A spring urges the wedge retainer downwardly relative to the bore so that when the cable is forced upwardly through the wedges, the cable is restricted from downward movement. (Page 2 paragraph 0004 lines 1-7).

**Claim 3**

3. A clamp for a cable support system to suspend an object from an overhead beam comprising:

a generally "C" shaped clamp body (14); (Page 4 paragraph 0021 lines 3-4; Figs 1-3)

a threaded fastener (16) threadingly received within one leg of said "C" shaped body (14) to clamp said "C" shaped body (14) onto said overhead beam (12); (Page 4 paragraph 0021 lines 4-5; Figs 1-3)

a vertical bore (20) through the vertical position of the "C" of said clamp body (14) for receiving a cable (34) to be suspended from said overhead beam (12); (Page 4 paragraph 0021 lines 6-7; Figs 1-3)

a conical end portion (22) at the lower part of said bore (20); (Page 4 paragraph 0021 lines 6-7; Figs 1-3)

a wedge retainer (24) vertically movable within said bore (20); (Page 4 paragraph 0021 lines 6-7; Figs 1-3)

wedges (26) retained by said wedge retainer (24) to contact said cable (34) within said bore (20) and to be forced against said cable (34) by said conical end portion (22) of said bore (20) when said retainer (24) is at the lower part of said bore (20); and (Page 4 paragraph 0021 lines 11-14; Figs 1-3)

a spring (28) to urge said wedge retainer (24) downwardly relative to said bore (20). (Page 4 paragraph 0021 lines 11-14; Figs 1-3)

**Claim 8**

A cable support system for hanging an object at a desired distance below an overhead beam comprising:

a clamp (10) having a generally "C" shaped clamp body (14) with a threaded fastener (16) threadingly received within one leg of said "C" shaped body (14) to clamp said "C" shaped body (14) onto said overhead beam (12) and a vertical bore (20) through said clamp body (14) to receive a cable (34) to be suspended from said overhead beam (12), said vertical bore (20) having a conical lower end portion (22) with a wedge retainer (24) and wedges (26) vertically movable within said bore (20) whereby said wedges (26) contact said lower conical end portion (22) and said cable (34) to wedge said cable (34) into position within said bore (20), the vertical position of said cable (34) relative to said bore (20) being vertically adjustable by forcing said cable (34) upwardly to release said wedges(26);

(Page 4 paragraph 0021 lines 1-14; Figs 1-3, Page 4 paragraph 0022 lines 1-8; Figures 1-3)

an object (72) to be suspended by said cable (34a) at a predetermined height

below said beam; and (Page 7 paragraph 0030 lines 6-8; Fig 9)

means for connecting said cable to said object (72). (Page 7 paragraph 0030 lines 6-8; Fig 9)

## 6. ISSUES

Claims 3-5, 8-10, and 14-16 were rejected. The rejection was made final. The rejection was based on:

(i) Claims 3-5 are indefinite under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention;

(ii) Claims 8, 14, and 15 are obvious under 35 U.S.C. § 103(a) over Redmen et al. (U.S. Patent No. 4,550,890) in view of Arakawa (U.S. Patent No. 4,656,698);

(iii) Claims 9, 10, and 16 are obvious under 35 U.S.C. § 103(a) over Redmen et al. (U.S. Patent No. 4,550,890) in view of Arakawa (U.S. Patent No. 4,656,698) and in further view of Sword (U.S. Patent No. 4,653,792);

(iv) Claims 3-5, 8, 14, and 15 are obvious under 35 U.S.C. § 103(a) over Hirt (U.S. Patent No. 3,321,161) in view of Arakawa (U.S. Patent No. 4,656,698); and

(v) Claims 9, 10, and 16 are obvious under 35 U.S.C. § 103(a) over Hirt (U.S. Patent No. 3,321,161) in view of Arakawa (U.S. Patent No. 4,656,698) and in further view of Sword (U.S. Patent No. 4,653,792).

The issue is whether the Examiner erred as a matter of law in finding the rejected claims:

(1) indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; and

(2) obvious in view of the references cited by the Examiner.

## 7. GROUPING OF CLAIMS

Claims 3-5 stand or fall together with respect to the 35 U.S.C. § 112 second

paragraph rejection. Claims 8, 14, and 15 stand or fall together with respect to the 35 U.S.C. § 103(a) rejection as being obvious over Redmen et al. (U.S. Patent No. 4,550,890) in view of Arakawa (U.S. Patent No. 4,656,698). Claims 9, 10, and 16 stand or fall together with respect to the 35 U.S.C. § 103(a) rejection as being obvious over Redmen et al. (U.S. Patent No. 4,550,890) in view of Arakawa (U.S. Patent No. 4,656,698) and in further view of Sword (U.S. Patent No. 4,653,792). Claims 3-5, 8, 14, and 15 stand or fall together with respect to the 35 U.S.C. § 103(a) rejection as being obvious over Hirt (U.S. Patent No. (3,321,161) in view of Arakawa (U.S. Patent No. 4,656,698). Claims 9, 10, and 16 stand or fall together with respect to the 35 U.S.C. § 103(a) rejection as being obvious over Hirt (U.S. Patent No. (3,321,161) in view of Arakawa (U.S. Patent No. 4,656,698) and in further view of Sword (U.S. Patent No. 4,653,792).

8. ARGUMENT §1.192 (c)(iv)

-I-

Examiner's contention that Claims 3-5 are indefinite  
pursuant to 35 U.S.C. § 112 second paragraph rejection

The Examiner has rejected claims 3-5 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention because “the vertical position” lacks antecedent basis. Claim 3 claims “a generally “C” shaped clamp body” and “a vertical bore through the vertical position of the “C” of said clamp body”. In a “C” shaped clamp it is inherent that there are two horizontal portions extending from ends of a vertical position which make up the “C” shape. “The vertical position” is inherent in the structure of the C shaped clamp body and therefore does not require an antecedent basis.

“Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface.” MPEP 2173.05(e). See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").

-II-

Examiner’s contention that claims 8, 14, and 15 are obvious under 35 U.S.C. § 103(a) over Redmen et al. (U.S. Patent No. 4,550,890) in view of Arakawa (U.S. Patent No. 4,656,698)

The Examiner has rejected claims 8, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Redman et al ‘890 in view of Arakawa ‘698.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

The Examiner has failed to show a *prima facie* case of obviousness in this case because she has not shown suggestion or motivation to modify or combine the reference teachings and she has not shown that the references teach or suggest all the limitations of claims 8, 14, and 15.



a. *suggestion or motivation*

“[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.” *In re Rouffett*, 149 F.3d 1350, 1357 (Fed Cir. 1998).

The Examiner has found most (but not all, which will be discussed below in section b) of the claimed elements in the prior art. However, the Examiner has failed to show any suggestion or motivation to modify or combine the references to teach the claim limitations. The Examiner is improperly using the Applicant’s invention as a blue print for piecing together elements in the prior art.

The Examiner has indicated the following as the basis for her conclusion of obviousness:

“It would have been obvious to one of ordinary skill in the art to modify the hanger and wedge assembly of Redman such that the strap is of cable type for engagement with the cable retention wedge system of Arakawa. Such modification would have involved mere substitution of one well-known cable suspension and wedging retainer assembly for another known device which is well within the ambit of one of ordinary skill in the art.” Page 3 of April 7, 2003 Office Action (emphasis added).

“A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were

individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references”. MPEP 2143 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

As can be seen from section 2143 of the MPEP, the Examiner has improperly made a judgment of obviousness solely on the basis that the references relied upon are well known in the art.

There is no suggestion or reason to modify Redman et al. ‘890 to include the device in Arkawa ‘698.

Redman et al. ‘890 teaches a pipe hanger that is secured to a beam having a strap with teeth along both edges of the strap. The strap wraps around a pipe with both ends of the strap attached to the pipe hanger. As can be seen in Fig 2 of Redman et al. ‘890 the locking nut assembly holds both ends of the strap that wraps around a pipe. Support for the object from this invention only comes from one support structure. The teeth on the strap engage the locking nut to hold the straps into place.

Arkawa ‘698 teaches an apparatus for holding one end of a wire to a first support structure and the other end of the wire to second support structure. Figures 5-8 show a wire supported in two separate locations and Column 4 lines 39-68 discusses how to use the apparatus to secure the wire (w) to two support locations.

There is no suggestion or motivation to take a device that holds one wire and is to be used on two support structures (Arkawa ‘698) and to incorporate it into a device that is designed to hold two ends of a strap with teeth that wraps around a pipe. The only motivation to make this combination is Applicant’s claim.

In fact, if this were to be done, the Redman et al. '890 device would not work for its intended purpose of holding a pipe. Redman et al. '890 teaches holding the object by means of wrapping the strap around the object with both ends being supported by the locking nut. Arkawa '698 is only capable of holding one end of a wire and does not disclose a means for attaching to an object. If the locking nut mechanism were replaced with the structure of Arkawa '698, a wire would be suspended without a means for attaching to an object. The means for holding an object taught by Redman et al. '890 is not compatible with Arkawa '698. There would be no way to wrap the other end of the wire around the object and feed the wire back into the apparatus of Arkawa '698 which is the holding means taught by Redman et al. '698. Because Redman would not work for its intended purpose if it incorporated Arkawa '698, there is no suggestion or motivation to make the change. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

*b. References must teach all of the claim limitations*

In order to establish a case of obviousness, the Examiner must show that the combined prior art teaches all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03.

That last element in claim 8 includes "means for connecting said cable to said object". This limitation invokes 35 U.S.C. 112, sixth paragraph because it contains "means for" and is modified by functional language; and is not modified by sufficient structure, material or acts for achieving the specified functions. MPEP 2181. "[T]he application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim. However, if a prior art reference teaches identity of function to

that specified in a claim, then under *Donaldson* an Examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the [Applicant's] specification." MPEP 2181. Paragraph 0030 and Figure 9 of Applicant's specification describes the structure for the "means for connecting said cable to said object".

The Examiner in her rejection of claims 8, 14, and 15 has failed to show that Redman et al. '890 or Arakawa '698 show "means for connecting said cable to said object."

Arkawa '698 does not show "a means for connecting the cable to said object" as the cable in Arkawa '698 is never shown directly connected to an object for support. The wire in Arkawa '698 is intended to be extended between two support structures. (Column 4 lines 39-41) The device shown in Arkawa is the means to connect the wire to a support structure not a means to hold an object.

Redman et al. '890 has a "strap that is placed around a pipe". This could be construed as a "means for connection strap to said object". However, it does not show the same or equivalent structure as the Applicant disclosed.

The Examiner failed to show all of the claim limitations as taught by the prior art references and therefore failed to establish a *prima facie* case of obviousness.

c. *Conclusion to Section II*

The Examiner has failed to provide a *prima facie* case of obviousness for claims 8, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Redman et al '890 in view of Arakawa '698.

-III-

Examiner's contention that claims 9, 10, and 16 are obvious under 35 U.S.C. § 103(a) over Redmen et al. (U.S. Patent No. 4,550,890) in view of Arakawa (U.S. Patent No. 4,656,698) and in further view of Sword (U.S. Patent No. 4,653,792)

The Examiner has rejected claims 9,10, and 16 under 35 U.S.C 103(a) as being unpatentable over Redman et al. '890 in view of Arakawa '698 as applied to claim 8, and further in view of Sword.

Claim 9 includes all of the limitations of Claim 8 but specifically claims the structure for "means for connecting said cable to said object:" which includes:

a permanent loop formed on the end of said cable; and  
passing said cable around said object and thereafter threading said cable through  
said permanent loop formed on the end of said cable and thereafter  
threading said cable into said vertical bore in said clamp.

The requirements for a prima facie case of obviousness are set forth in section II and will not be repeated. The argument set forth above against combining Redmen et al. '890 and Arkawa '698 apply to this basis of rejection and will not be repeated again.

The Examiner has indicated "It would have been obvious to one of ordinary skill in the art to modify the object securing means of Redman and Arakawa combined such that it is of the loop as taught by Sword for engagement with the vertical bore of Redman and Arakawa combined to facilitate a quick mounting and securing system".

One would have to first believe it would be obvious to combine Redman and Arakawa which has been demonstrated above not to be the case.

Again the Examiner has just stated that "one of ordinary skill in the art" could have made

this modification because all the limitations were taught by the prior art without indicating any suggesting or teaching to modify the prior art. This does not establish a prima facie case of obviousness. MPEP 2143.

The Examiner's statement "it would have been obvious... to modify the object securing means of Redman and Arakawa combined" is wrong. There can be no such apparatus. As indicated earlier, Arakaw'698 does not show an "object securing means". The "object securing means" taught by Redman '890 would not work with the apparatus in Arakaw '698. Thus, the combined apparatus would have no object securing means, but more importantly would not be combined because the object securing means taught by Redman could not be used with the Arakaw apparatus and thus would not let Redman work for its intended purpose.

The "object securing means" taught by Sword '792 would not work with Redman '890. As this is the case, there is no motivation or suggestion to combine the art.

The Examiner has used the Applicant's claimed invention as a blueprint and has combined references without any teaching or motivation to do so. It is well established law that it is improper to use Applicant's claims as a blueprint and to reconstruct the invention from the prior art using the claim as a blueprint. *Grain Processing Corp. v. American Maize Products Corp.* 840 F.2d 902 (Fed.Cir.1988); *Smith Kline Diagnostics Inc. v. Helena Laboratories Corp.* 859 F.2d. 878 (Fed. Cir. 1988); *In re Stencel*, 828 F.2d. 751 (Fed. Cir. 1987); *In re Dow Chemical*, 837 F.2d. 469 (Fed. Cir. 1988); *Northern Telecom, Inc. v. Datapointe Corp.* 908 F.2d. 931; (Fed. Cir. 1990 ), *cert. denied*, 11 S.Ct.296 (1990); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

-IV-

Examiner's contention that claims 3-5, 8, 14, and 15 are obvious under 35 U.S.C. § 103(a) over Hirt (U.S. Patent No. (3,321,161) in view of Arakawa (U.S. Patent No. 4,656,698);

The Examiner has rejected claims 3-5, 8, 14, 15 under 35 U.S.C. 103(a) as being unpatentable over Hirt '161 in view of Arakawa '698.

The Examiner again has just stated that "one of ordinary skill in the art" could have made this modification because all the limitations were taught by the prior art without indicating any suggesting or teaching to modify the prior art. This does not establish a prima facie case of obviousness. MPEP 2143.

"It would have been obvious to one of ordinary skill in the art to modify the rod suspension system of Hirt '11' such that it is of a cable type with a corresponding cable retention wedge system of Arakawa since suspending object via cables are old and well-known in the art. Further, such modification would have involved a mere substitution of one well-known suspension system for another known device which is well within the ambit of one of ordinary skill in the art." Page 5 of April 7, 2003 Office Action (emphasis added).

The Examiner has indicated that suspending an object via cables is old. "Examiner takes official notice that using cables to support objects are notoriously old and well-known as demonstrated." The Applicant has not claimed the use of cables by themselves for suspending an object. While the use of cable for suspending objects is old, there has been no shown motivation to use a cable in combination with a generally "C" shaped clamp. A new combination of old subject matter is patentable. *Rosemount, Inc. v. Beckman Instruments, Inc.* 727 F.2d 1540 (Fed. Cir. 1984).

The Examiner has again used the Applicant's claimed invention as a blueprint and has

combined references without any teaching or motivation to do so.

Hirt '161 teaches a hanger clamp that is secured to a beam having threaded hanger rods with carry hanger straps attached to the object. As can be seen in Fig 1 of Hirt '161, the support for the object from this invention only comes from 1 location.

Arkawa '698 teaches an apparatus for holding one end of a wire to a first support structure and the other end of the wire to second support structure. Figures 5-8 show a wire supported in two separate locations and Column 4 lines 39-68 discusses how to use the apparatus to secure the wire (w) to two support locations.

There is no suggestion or motivation to take a device that holds a wire and is to be used on two support structures (Arkawa '698) and to incorporate it into a device that uses a rod with a carry strap to support a pipe from one location. The only motivation to make this combination is Applicant's claim.

An Examiner must provide the "impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. *Ex Parte Legengood*, 28 U.S.P.Q 2d 1300, 13\_\_ (Pat Bd. App. 1993). The Examiner has not done this. There is no suggestion or impetus to combine the teachings. There must be "something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination".

*Lindemann Maschinefabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462 (Fed Cir. 1984). The Examiner has not shown the motivation in the prior art for one of ordinary skill in the art to replace the hanger rods with carry hanger straps with a cable and cable support structure. The Examiner has noted that the use of cables to support an object is old and well known. Logic would suggest that if it were obvious to combine cables with Hirt '161, Hirt



would have done so or at least suggested to do so.

Absent a showing in the prior art, the Examiner has impermissibly used hindsight by using the Applicant's teaching as a blueprint to hunt through prior art for the claimed elements and combined them as claimed. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

-V-

Examiner's contention that claims 9, 10, and 16 are obvious under 35 U.S.C. § 103(a) over Hirt (U.S. Patent No. (3,321,161) in view of Arakawa (U.S. Patent No. 4,656,698) and in further view of Sword (U.S. Patent No. 4,653,792) .

Claims 9, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirt '161 in view of Arakawa '698 as applied to claim 8 above and in further view of Sword '792.

As indicated above, there is no motivation or teaching to suggest the combination of Hirt '161 with Arakawa '698.

There is no motivation or teaching to suggest the combination of Hirt '161 with Arakawa '698 with Sword '792.

In order to properly combine references to reject a claimed invention, the references themselves must suggest the desirability of the combination. See: *In re Laskowski*, 10 USPQ 2d. 1397 (CAFC 1989) and the cases cited therein. As set forth in *In re Laskowski*, the "mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." As further stated in *In re Laskowski*, "there must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references"; and still further, "obviousness cannot be established by combining pieces of prior art absent some teaching, suggestion, or

incentive supporting the combination.”

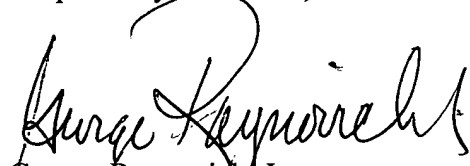
This reference could not be applicable to the combination that rejects Applicant’s claims absent the teaching of Applicant’s own invention.

CONCLUSION

It is respectfully submitted that the Applicant’s claims 3-5, 8-10 and 14-16 are not obvious in view of the art and are patentable and the Examiner’s rejection of the claims is erroneous as a matter of law and should be reversed and the application allowed.

Applicant hereby requests an oral hearing for this Appeal.

Respectfully submitted,



George Raynovich, Jr.  
Reg. No. 19,829



John C. Thomas III  
Reg. No. 52,282

Paul A. Beck & Associates  
Suite 100  
1575 McFarland Road  
Pittsburgh, PA 15216-1808

Attorneys for Appellants

## **Appendix of Claims**

3. A clamp for a cable support system to suspend an object from an overhead beam comprising:
  - a generally “C” shaped clamp body;
  - a threaded fastener threadingly received within one leg of said “C” shaped body to clamp said “C” shaped body onto overhead beam;
  - a vertical bore through the vertical position of the “C” of said clamp body for receiving a cable to be suspended from said overhead beam;
  - a conical end portion at the lower part of said bore;
  - a wedge retainer vertically movable within said bore;
  - wedges retained by said wedge retainer to contact said cable within said bore and to be forced against said cable by said conical end portion of said bore when said retainer is at the lower part of said bore; and
  - a spring to urge said wedge retainer downwardly relative to said bore.
4. The clamp of claim 3 wherein the vertical position of said cable is adjustable by forcing said cable upwardly from the bottom of said bore to release said wedges and permit upward movement of said cable relative to said clamp.
5. The clamp of claim 4 wherein said wedge retainer has a threaded portion protruding below said bore with a lock nut threaded onto said wedge retainer lower portion so that after said cable is positioned within said clamp “C” shaped body at the desired

height, said lock nut is tightened against said clamp "C" shaped body to lock said wedge retainer and prevent movement of said wedge retainer relative to said bore.

8. A cable support system for hanging an object at a desired distance below an overhead beam comprising:

a clamp having a generally "C" shaped clamp body with a threaded fastener threadingly received within one leg of said "C" shaped body to clamp said "C" shaped body onto said overhead beam and a vertical bore through said clamp body to receive a cable to be suspended from said overhead beam, said vertical bore having a conical lower end portion with a wedge retainer and wedges vertically movable within said bore whereby said wedges contact said lower conical end portion and said cable to wedge said cable into position within said bore, the vertical position of said cable relative to said bore being vertically adjustable by forcing said cable upwardly to release said wedges;

an object to be suspended by said cable at a predetermined height below said beam; and

means for connecting said cable to said object.

9. The cable support system of claim 8 wherein said means for connecting said cable to said object includes:

a permanent loop formed on the end of said cable; and

passing said cable around said object and thereafter threading said cable through

said permanent loop formed on the end of said cable and thereafter  
threading said cable into said vertical bore in said clamp.

10. The cable support system of claim 9 wherein the height of said object below said beam is controlled by the amount of said cable threaded upwardly through said vertical bore in said clamp.
14. The cable support system of claim 8 wherein said clamp vertical bore includes a spring that urges said wedge retainer downwardly relative to said bore.
15. The cable support system of claim 8 wherein said clamp wedge retainer has a threaded portion protruding below said bore with a lock nut threaded onto said wedge retainer lower portion.
16. The cable support system of claim 10 wherein said clamp wedge retainer has a threaded portion protruding below said bore with a lock nut threaded onto said wedge retainer lower portion so that after said cable is positioned within said clamp "C" shaped body at the desired height, said lock nut is tightened against said clamp "C" shaped body to lock said wedge retainer and prevent movement of said wedge retainer relative to said bore.